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REMARKS

In the Office Action, the Examiner noted that the claims 1-52 are pending in the application, **that claims 11, 14, 15, 25-29 and 43-52 are allowed**, and that the claims 1-10, 12, 13, 16-24 and 30-42 are rejected on the ground of **non-statutory** obviousness-type double patenting. Applicant graciously acknowledges the Examiner's indication of allowable subject matter.

By this response, no claims have been amended. Thus, claims 1-52 remain pending in the application. Applicant respectfully traverses the rejections for the reasons indicated below.

Rejections Under Non-Statutory Obviousness Type Double Patenting Over Stebbings, U.S. Patent No. 6,636,689

Claims 1-9, 12, 13, 16-23, 30-36 and 38-42 are rejected on the ground of **non-statutory** obviousness-type double patenting over Claims 1-9, 12, 13, and 32-37 of U.S. 6,636,689 to David Stebbings. Applicant respectfully traverses this rejection.

As discussed previously in connection with the previous same invention double patenting rejection, which has been withdrawn by the Examiner, Stebbings U.S. Patent No. 6,636,689 does not **claim** the use/application of **modulation rules as in the present application**. Rather, Stebbings claims "detecting the modulation of the at least one of said pit depth, pit width and

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pit track.” Accordingly, Stebbings claims a distinct invention than that being claimed in the present application, which claims “**modulation rule**.” The use of **modulation rules** is a distinct and separate design from the use of **physical modulation characteristics** of the pit depth, pit width and/or pit track, as claimed in Stebbings. We have included a claim comparison in the enclosed Attachment highlighting these differences.

As stated by the Federal Circuit in *Studiengesellschaft Kohle mbH v. Northern Petrochemical Co.*, 784 F.2d 351, 228 USPQ 837, 840 (Fed. Cir. 1986) (per curiam) (quoting *In re Vogel*, 422 F.2d 438, 441, 164 USPQ 619, 621–22 (C.C.P.A. 1970)):

By “same invention” we mean identical subject matter. Thus the invention defined by a claim reciting “halogen” is not the same as that defined by a claim reciting “chlorine,” because the former is broader than the latter. . . . **A good test, and probably the only objective test, for “same invention,” is whether one of the claims would be literally infringed without literally infringing the other.** If it could be, the claims do not define identically the same invention.

In accordance with 37 C.F.R. Section 1.130, Applicant is hereby submitting a Terminal Disclaimer under 37 C.F.R. Section 1.321 to remove the Stebbings patent as prior art.

Accordingly, Applicant respectfully submits that the obviousness-type double patenting rejection should be withdrawn, and such action is earnestly requested. In addition, since

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Applicant is filing a Terminal Disclaimer in connection with the present application, no issues with respect to obviousness type double patenting are present.

Accordingly, for these reasons, Applicant respectfully requests withdrawal of this rejection.

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CONCLUSION

Applicant respectfully submits that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicant does not concede that the cited prior art shows any of the elements recited in the claims. However, Applicant has provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples Applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicant asserts that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicant has emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicant does not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicant is providing examples of why the claims described above are distinguishable over the cited prior art.

Applicant wishes to clarify for the record, if necessary, that the claims have been amended to expedite prosecution and/or explicitly recite that which is already present within the claims. Moreover, Applicant reserves the right to pursue the original and/or complimentary subject matter recited in the present claims in a continuation application.

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Any claims that have been cancelled are hereby cancelled without prejudice or disclaimer, and Applicant reserves the right to further prosecute these claims in continuing applications. In addition, Applicant has attempted to claim all embodiments disclosed in the present application, and no disclaimer of any embodiments is hereby intended by the presently pending claims.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicant's best attempt at providing one or more definitions of what the Applicant believes to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicant is seeking for this application. Therefore, no estoppel should be presumed, and Applicant's claims are intended to include a scope of protection under the Doctrine of Equivalents and/or statutory equivalents, i.e., all equivalents that are substantially the same as the presently claimed invention.

Further, Applicant hereby retracts any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicant specifically retracts statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

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For all the reasons advanced above, Applicant respectfully submits that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicant respectfully submits that the Application is in condition for allowance, and that such action is earnestly solicited.

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AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

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